

HP Docket No. 10003333-1

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 2, 4, 18, and 30-32 have been amended, claims 22-29 have been canceled, and new claims 33-36 have been added.

Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections**Rejection Under 35USC Section 102(e)**

Claims 1-2, 5-6, 9-11, 13, 15, 18, 20-21, and 31 have been rejected under 35 USC Section 102(e), as being anticipated by U.S. patent 6,381,634 to Tello et al. ("Tello"). Applicants respectfully traverse the rejection and request reconsideration based on the amendments to claims 2, 4, 18, and 31, and features in the other claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under 102(b), "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CAFC) 221 U.S.P.Q. 385. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

HP Docket No. 10003333-1

Independent claim 1, and its dependent claims 2, 5-6, and 9-11, are patentably distinguishable over the cited reference because claim 1 emphasizes the novel features of the present invention which identify an unknown mail server through selection by a machine of one of a number of mail server names, and then determining if that mail server name corresponds to the unknown mail server. In this regard, claim 1 specifies a method of communicating with an unknown mail server which includes:

“determining whether a machine-selected one of a plurality of mail server names corresponds to a mail server associated with an on-line provider; and
communicating with the mail server associated with the on-line provider when the machine-selected one of a plurality of mail server names corresponds to the mail server.”

The Tello reference describes a “method ... for e-mail portability” in which “a well-known address ... is translated to the corresponding literal address” (Abstract), to “allow an Internet user to keep the same e-mail address while changing ISPs” (col. 1, lines 28-30). For example, according to the Tello reference an e-mail sent from the user “smith@stuff.net” to the well-known e-mail address “name@@wellknown” would be translated into the literal e-mail address “userx@commercial_isp.com” (Fig. 3; col. 5, lines 29-35). Such a translation is performed over communication paths “b” and “c” (Fig. 1) between ISP 100 and SCP 200.

The novel features of the present invention are not anticipated by the Tello reference in that the Tello reference does not determine whether a machine-selected one of a plurality of mail server names corresponds to a mail server associated with an on-line provider. The Tello reference does not explicitly disclose mail servers, mail server names, or determining mail servers from mail server names, which the present invention would use to establish the communication path “a” between the user and the ISP 100 (Fig. 1) of the Tello reference. Furthermore, even assuming only for the sake of argument that the domain name (“stuff.net”) of the on-line provider (ISP 100) is its mail server name, and the IP address (140.255.160.22) of the on-line provider (ISP 100) is its mail server (col. 5, lines 3-8), there is no disclosure in the Tello reference that the mail server is unknown to the e-mail application program, or that the mail server is determined from a machine-selected one of a plurality of mail server names.

HP Docket No. 10003333-1

Since the element of determining whether a machine-selected one of a plurality of mail server names corresponds to a mail server associated with an on-line provider is absent from the Tello reference, the rejection is improper at least for that reason and should be withdrawn.

Dependent claim 2 (amended), and its sub-dependent claims 5-6 and 9, are further patentably distinguishable over the cited reference because claim 2 emphasizes the novel features of the present invention which verify that the mail server name corresponds to the mail server associated with the on-line provider. In this regard, claim 2 specifies that the determining includes:

“linking to a mail port of a computer having the mail server name so as to verify whether the mail server name corresponds to the mail server associated with the on-line provider.”

The novel features of the present invention are not anticipated by the Tello reference in that the Tello reference discloses neither the mail server name, a mail port of a computer having the mail server name, nor linking to the mail port in order to verify whether the mail server name corresponds to the mail server. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 5, and its sub-dependent claim 6, are further patentably distinguishable over the cited reference because claim 5 emphasizes the novel features of the present invention which obtain from a database the mail server name associated with the suffix portion of the e-mail address. In this regard, claim 5 specifies that the e-mail address includes a suffix portion and the converting includes:

“obtaining the mail server name associated with the suffix portion from a database.”

The Tello reference discloses an e-mail address “smith@stuff.net” with a suffix portion “stuff.net” that is associated with the on-line provider. However, it does not teach or suggest obtaining a mail server name associated with the suffix portion “stuff.net” from a database. Rather, what is obtained from the database of the Tello reference is the literal e-mail address “userx@commercial_isp.com” that is associated with the recipient’s well-known e-mail address “name@@wellknown” (col. 3, lines 48-65; Fig. 3). Therefore, the rejection is

HP Docket No. 10003333-1

improper and should be withdrawn.

Dependent claim 9 is further patentably distinguishable over the cited reference because claim 9 emphasizes the novel features of the present invention that determine an IP address of the mail server. In this regard, claim 9 specifies that the linking includes:

“communicating with a domain name server to determine a mail server IP address corresponding to the mail server name; and
connecting to the mail port of the mail server IP address.”

The novel features of the present invention are not anticipated by the Tello reference in that the Tello reference discloses neither a domain name server, nor communicating with it to determine a mail server IP address corresponding to the mail server name. Therefore, the rejection is improper and should be withdrawn.

Independent claim 13, and its dependent claims 15 and 31, are patentably distinguishable over the cited reference because claim 13 emphasizes the novel features of the present invention for connecting to an Internet service provider. In this regard, claim 13 specifies a system for e-mailing information to a recipient over the Internet that includes:

“an electronic device adapted for periodic connection to an Internet service provider and to a configuration computer, the electronic device having
a parameter memory,
a storage subsystem coupled to the parameter memory and responsive to a command from the configuration computer for storing configuration parameters in the parameter memory, and
an e-mail subsystem coupled to the parameter memory and responsive to a user request to connect to an e-mail server of the Internet service provider using a server name and to e-mail the information to the recipient; and
a configuration program executable by the configuration computer to determine the server name from the user's e-mail address.”

The Tello reference describes a portion of the Internet that includes an ISP 100, a translator (SCP 200), and a second ISP 300 (col. 3, lines 26-30), in which a mail daemon on ISP 100 parses e-mail messages sent from the user over communication path “a” to ISP 100 for delivery. If the mail daemon detects a well-known name value in the “To:” field of an e-mail message, it accesses the translator to obtain the literal e-mail address value, which

HP Docket No. 10003333-1

corresponds to the second ISP 300 (col. 4, line 41 – col. 5, line 42). In the system of Fig. 1 of the Tello reference, the electronic device of the present invention would be located at the User end of communication path “a”, and would establish communication path “a” between the User and ISP 100 (Fig. 1). The Tello reference does not disclose such an electronic device having a parameter memory, a storage subsystem, an e-mail subsystem that connects to an e-mail system of an ISP using a server name, nor a configuration computer that periodically connects to the electronic device and has a configuration program to determine the server name from the user’s e-mail address. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Dependent claim 31 (amended) is further patentably distinguishable over the cited reference because claim 31 emphasizes the novel features of the present invention that include a multifunction peripheral. In this regard, claim 31 specifies that:

“the electronic device is a multifunction peripheral including at least two devices selected from the group consisting of a printer, a scanner, a copier, and a fax machine.”

The novel features of the present invention are not anticipated by the Tello reference in that the Tello reference does not disclose the electronic device including any two of a printer, a scanner, a copier, and a fax machine. Therefore, the rejection is improper and should be withdrawn.

Independent claim 18 (amended), and its dependent claims 20-21, are patentably distinguishable over the cited reference because claim 18 emphasizes the novel features of the present invention which configures an electronic device to send e-mail via a mail server. In this regard, claim 18 specifies a program storage medium which includes:

“a first segment of the instructions configured to convert an e-mail address for a user of the on-line access provider to a mail server name;

a second segment of the instructions configured to connect to the mail server using access information so as to verify validity of the mail server name; and

a third segment of the instructions configured to download the mail server name and a predetermined portion of the access information to the electronic device.”

As explained heretofore with reference to claim 13, the Tello reference does not

HP Docket No. 10003333-1

disclose downloading the mail server name and access information to an electronic device, and therefore the rejection is improper at least for that reason and should be withdrawn.

Rejection Under 35USC Section 103

Claims 3-4, 7-8, 12, 14, and 19 have been rejected under 35 USC Section 103 (a), as being unpatentable over U.S. patent 6,381,634 to Tello et al. ("Tello") in view of U.S. patent 5,987,508 to Agraharam et al. ("Agraharam"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 4 and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Dependent claim 3, and its sub-dependent claims 4, 7-8, and 12, are patentably distinguishable over the cited references for the reasons cited previously for independent claim 1, and further because claim 3 emphasizes the novel features of the present invention which convert the e-mail address to a mail server name. In this regard, claim 3 specifies a method:

“wherein the e-mail address includes a suffix portion; and
wherein the converting includes
prepending a selected one of a predetermined set of mail server prefixes to the suffix portion to form the mail server name associated with the on-line provider.”

The Agraharam reference teaches “[a]ddress translation between a recipients alias telephone number e-mail address and that recipient’s actual e-mail address” by prepending a telephone number to “the domain address of a translation server”, forming, for example, the e-mail address “2015558765@email.att.net” (col. 3, lines 24-47). Applicants’ claimed invention does not translate e-mail addresses. Neither Agraharam alone, nor in combination with Tello, teach or suggest prepending a selected one of a predetermined set of mail server prefixes to the suffix portion to form the mail server name associated with the on-line provider, as claimed by applicants.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the

HP Docket No. 10003333-1

claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 7 is further patentably distinguishable over the cited references because claim 7 emphasizes the novel features of the present invention which, if the mail server name is not verified as valid, use a different mail server prefix. In this regard, claim 7 specifies a method in which:

“if validity of the mail server name is not verified, repeating the prepending and linking using a different one of the predetermined set of mail server prefixes.”

The Agraharam reference teaches using a user's telephone number as an e-mail prefix. It does not suggest using a different one of a predetermined set of telephone numbers. Neither Agraharam alone, nor in combination with Tello, teach or suggest repeating the prepending and linking using a different one of the predetermined set of mail server prefixes if validity of the mail server name is not verified, as claimed by applicants.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 12 is further patentably distinguishable over the cited references because claim 12 emphasizes the novel features of the present invention which, if the mail server name is not verified as valid, use a different mail server prefix. In this regard, claim 12 specifies a method:

“wherein the suffix portion includes at least two domain levels and a separator between each of the at least two domain levels, and wherein the converting further includes stripping a left-most domain level and a left-most separator from the suffix portion prior to the prepending if the suffix portion includes more than two domain levels.”

The Agraharam reference illustrates, by way of example, a suffix portion with more than two domain levels: “email.att.net” (col. 3, line 34), and prepends the telephone number and “@” separator to that suffix portion to form “2015558765@email.att.net” (col. 3, line 47)

HP Docket No. 10003333-1

without stripping the left-most domain ("email") and separator (".") from the suffix.

Therefore, neither Agraharam alone, nor in combination with Tello, teach or suggest the stripping operation as claimed by applicants.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 4 (amended), and its sub-dependent claim 8, are patentably distinguishable over the cited references because claim 4 emphasizes the novel features of the present invention which convert the e-mail address to a mail server name. In this regard, claim 4 specifies a method:

"wherein the e-mail address includes a first prefix portion and a first separator portion, and
wherein the converting includes
stripping the first prefix portion and the first separator portion from the e-mail address, and
appending a second separator different from the first separator to the selected one of a predetermined set of mail server prefixes so as to form the mail server name associated with the on-line provider."

The Agraharam reference illustrates a domain address, "email.att.net" (col. 3, line 34), to which a telephone number and "@" separator is prepended. It does not disclose stripping a prefix and separator portion from an e-mail address. Therefore, neither Agraharam alone, nor in combination with Tello, teach or suggest the stripping operation as claimed by applicants.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 8 is further patentably distinguishable over the cited references because claim 8 emphasizes the novel features of the present invention as to how an e-mail

HP Docket No. 10003333-1

address is converted to a mail server name. In this regard, claim 8 specifies a method wherein:

“the suffix is a domain identifier,
the first prefix is a mailbox identifier,
the first separator is an ‘@’ symbol,
the second prefix is a mail server prefix, and
the second separator is a ‘.’ symbol.”

In applicants’ claimed invention, an e-mail address of the form “<first prefix>@<suffix>” is converted to a mail server name of the form “<second prefix>.<suffix>”. Neither the Agraharam reference nor the Tello reference, which convert or map one e-mail address to another, perform such an operation. Therefore, neither Agraharam alone, nor in combination with Tello, teach or suggest the conversion as claimed by applicants.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 14 is patentably distinguishable over the cited references for the reasons cited previously for independent claim 13, and further because claim 14 emphasizes the novel features of the present invention which convert the e-mail address to a mail server name. In this regard, claim 14 specifies that the configuration program includes:

“a parser to isolate a suffix from the user’s e-mail address; and
a concatenator to prepend one of a predefined set of mail server prefixes to the suffix to form the server name.”

For similar reasons as has been discussed subsequently with regard to claim 13, the Tello reference does not disclose a configuration program having a parser and a concatenator as claimed by applicants. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 19 is patentably distinguishable over the cited references at least for the reasons cited previously for independent base claim 18.

HP Docket No. 10003333-1

Claims 16-17 and 32 (amended) have been rejected under 35 USC Section 103 (a), as being unpatentable over U.S. patent 6,381,634 to Tello et al. ("Tello") in view of U.S. patent 6,525,768 to Obradovich. Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claim 32 and features in the claims which are neither disclosed nor suggested in the cited references, taken either alone or in combination.

Dependent claim 16, and its sub-dependent claim 17, are patentably distinguishable over the cited references for the reasons cited previously for independent claim 13, and further because claim 16 emphasizes the novel features of the present invention which convert the e-mail address to a mail server name. In this regard, claim 16 specifies a system wherein:

"the configuration program further determines a maximum e-mail message size supported by the e-mail server."

The Obradovich reference teaches a system that "transmits the requested data ... via e-mail ... in multiple files, each less than the maximum size of the PCD" (col. 29, 27-31), which is "[a] personal communications device with ... a GPS receiver and a display" (Abstract). In applicants' claimed invention, the maximum e-mail message size is not limited by the device from which the e-mail is sent, but rather by the size limitations of the e-mail server. Therefore, neither Obradovich alone, nor in combination with Tello, teach or suggest the maximum e-mail message size as claimed by applicants.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the claimed features of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper and should be withdrawn.

Dependent claim 32 (amended) is patentably distinguishable over the cited references at least for the reasons cited previously for independent base claim 13.

HP Docket No. 10003333-1

Claim 30 (amended) has been rejected under 35 USC Section 103 (a), as being unpatentable over U.S. patent 6,381,634 to Tello et al. ("Tello") in view of U.S. patent 6,574,670 to Eguchi. Applicants respectfully traverse the rejection and request reconsideration based on features in claim 30 which are neither disclosed nor suggested in the cited references, taken either alone or in combination. Dependent claim 30 (amended) is patentably distinguishable over the cited references for the reasons cited previously for independent base claim 13.

Conclusion

Attorney for Applicant(s) has carefully reviewed each one of the cited references, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.